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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,689	09/26/2001	Mark Stewart Nichols	05222.00 163	3228

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EXAMINER

HIRL, JOSEPH P

ART UNIT PAPER NUMBER

2121

DATE MAILED: 03/29/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

SL

Office Action Summary

Application No.

09/868,689

Applicant(s)

NICHOLS ET AL.

Examiner

Joseph P. Hirl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to an AMENDMENT entered January 23, 2004 for the patent application 09/868,689 filed on September 26, 2001.

2. The First Office Action of October 23, 2003 is fully incorporated into this Final Office Action by reference.

3. The claims and only the claims form the metes and bounds of the invention.

"Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

4. Examiner's Opinion:

Para 3 above applies. The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Independence means that there is no correlation. If there is correlation, then conversely, independence is not established. The applicant's invention seeks substantial commonality in software which means that the activities of the students for a given subject will be similar...will have correlation...not independent.

Status of Claims

5. Claims 1 and 10 are amended. Claims 1-18 are pending.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1 and 10 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

From the specification at pg. 7, lines 16-33:

There are several approaches to capturing commonalities for reuse. Two of the more common approaches are framework-based and component-based. To help illustrate the differences between the two approaches, we will draw an analogy between building an application and building a house. One can construct a house from scratch, using the raw materials, 2x4s, nails, paint, concrete, etc. One can also construct an application from scratch, using the raw materials of new designs and new code. The effort involved in both undertakings can be reduced through framework-based and/or component-based reuse. Within the paradigm of framework-based reuse, a generic framework or architecture is constructed that contains commonalities. In the house analogy, one could purchase a prefabricated house framework consisting of floors, outside walls, bearing walls and a roof. The house can be customized by adding partition walls, wall-paper, woodwork, carpeting etc. Similarly, prefabricated application frameworks are available that contain baseline application structure and functionality. Individual applications are completed by adding specific functionality and customizing the look-and-feel. An example of a commonly used application framework is Microsoft Foundation Classes. It is a framework for developing Windows applications using C++. MFC supplies the base functionality of a windowing application and the developer completes the application by adding functionality within the framework. Framework-based reuse is best suited for capturing template-like features, for example user interface

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management, procedural object behaviors, and any other features that may require specialization. Some benefits of using a framework include:

Extensive functionality can be incorporated into a framework. In the house analogy, if I know I am going to build a whole neighborhood of three bedroom ranches, I can build the plumbing, wiring, and partition walls right into the framework, reducing the incremental effort required for each house. If I know I am going to build a large number of very similar applications, they will have more commonalities that can be included in the framework rather than built individually.

Simply stated, the applicant has deliberately set up software commonality among individual participants. Such commonality will allow for similar (identical) student activity which, of course, would mean the progress of a student would not be different (independent) from that of another student. Superficial effects such as coloring of the walls or skin of the computer are not relevant to a utility patent. To one of ordinary skill in the art, independence means that there is no correlation. Similarity means there will be substantial correlation...no independence.

Further, the specification is silent on "the progress being independent of an activity of another student."

Response to Arguments

6. The Information Disclosure Statement related to non-US patent literature is accepted. The Information Disclosure Statement related to US Patents is rejected since the specific nature of the search has not been described (IDS ltr. Dtd. January 29, 2024, Pg. 2, lines 6-9). The Examiner is of the opinion that most of the documents searched as specified in the related IDS and in the manner described would not have been in a proper field of search. From the MPEP at page 600-118, col 1: "Consideration by the

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examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search." If the applicant wishes to resubmit the related documents, it will be necessary to provide a short statement with each one justifying why it should be in the proper field of search (i.e. relevant to the application). The IDS related to patents has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C (1).

7. The objection to the drawings is withdrawn.

8. The substitute specification is accepted. However, the abstract is missing.

Therefore the objection to the specification remains.

9. The claim objection is withdrawn.

10. Applicant's arguments filed on January 23, 2004 related to Claims 1-18 have been fully considered but are not persuasive.

In reference to Applicant's argument:

The Applicant has amended claim 1 to include the feature of "monitoring progress of a student toward the goal and providing feedback that further assists the student in accomplishing the goal, the progress being independent of an activity of another student". (Emphasis added.) The present patent application, for example, teaches:

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The system utilizes an artificial intelligence engine driving individualized and dynamic feedback with synchronized video and graphics used to simulate real-world environment and interactions. Multiple "correct" answers are integrated into the learning system to allow individualized learning experiences in which navigation through the system is at a pace controlled by the learner. A website is linked to the presentation to provide context-sensitive information to assist the learner.

Brown, however, does not teach or even suggest this feature. For example, Brown teaches about "Setting a common goal, such as maintaining good health in a particular way of correlating the outcomes of two player's actions in order to encourage cooperation and communications between the players. Another unique way of correlating the outcomes of the actions of two or more players is based on what is generally known as the Prisoner's Dilemma." (Column 5, lines 61-67. Emphasis added.) Brown teaches about "cooperation and discussion between game players by correlating the player's progress toward achieving their game objective". (Column 2, lines 11-13.) In fact, rather than having independence between players, Brown teaches away from independence and teaches about dependence between players. Clearly, Brown does not teach or even suggest the feature of "monitoring progress of a student toward the goal and providing feedback that further assists the student in accomplishing the goal, the progress being independent of an activity of another student".

Similarly, the Applicant has amended claim 10 to include the element having "logic that monitors progress of a student toward the goal and provides feedback that further provides the Student assistance in accomplishing the goal, the progress being independent of an activity of another student."

Examiner's response:

Para 3 and 7 above apply. It is only the claims that establish the metes and bound so the invention. As stated above and indicated in the applicants specification at pg. 7, lines 16-33, the applicant undertakes very specific efforts to provide commonality of activity (experience) and hence there isn't any independence...the activities correlate. Brown anticipates the applicant's invention.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

12. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown (US Patent 6, 210, 272, referred to as **Brown**).

Claim 1

Brown anticipates a) receiving indicia representative of a goal (**Brown**, Figs. 2-A, 2-B); (b) integrating examples into the presentation to provide assistance with achieving the goal (**Brown**, c 5, l 44-53); (c) monitoring progress of a student toward the goal and providing feedback that further assists the student in accomplishing the goal (**Brown**, c 6, l 8-11); and (d) providing a linkage to a website of information to assist with achieving the goal (**Brown**, c 7, l 38-63).

Claims 2, 11

Brown anticipates the website comprises a plurality of HTML documents (**Brown**, c 7, l 38-63; Examiner's Note (EN): to one of ordinary skill in the art, HTML documents are ASCII files which are distributed among user computers and the server in a network architecture).

Claims 3, 12

Brown anticipates a relational database of information (**Brown**, c 7, l 38-63; EN: to one of ordinary skill in the art, a relational database is a database that is organized and accessed according to relationships between data items).

Claims 4, 13

Brown anticipates the website is keyword indexed (**Brown**, c 5, l 29-33).

Claims 5, 14

Brown anticipates the website includes linkages to the presentation (**Brown**, c 7, l 38-63).

Claims 6, 15

Brown anticipates the website includes navigation information for the presentation (**Brown**, c 5, l 29-33; EN: navigation is synonymous with a treed selection).

Claims 7, 16

Brown anticipates the website is indexed in a hierarchical manner (**Brown**, c 5, l 29-33; EN: the decision listing is a form of an indexed hierarchy) .

Claims 8, 17

Brown anticipates the website includes presentations on related presentation information (**Brown**, c 5, l 29-33; EN: the presentation information is the listing).

Claims 9, 18

Brown anticipates the website information is based on the presentation context (**Brown**, c 5, l 29-53; c 7, l 38-63).

Claim 10

Brown anticipates (a) a processor (**Brown**, c 7, l 38-63); (b) a memory that stores information under the control of the processor (**Brown**, c 7, l 38-63) ; (c) logic that integrates examples into the presentation to provide assistance with achieving the goal (**Brown**, c 5, l 44-53); (d) logic that monitors progress of a student toward the goal and provides feedback that further provides the student assistance in accomplishing the

goal (**Brown**, c 6, l 8-11); and (e) logic that provides a linkage to a website of information to assist with achieving the goal (**Brown**, c 7, l 38-63).

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Claims 1-18 are rejected.

Correspondence Information

16. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (703) 305-1668. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anil Khatri can be reached at (703) 305-0282.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,
Washington, D. C. 20231;

or faxed to:

(703) 746-7239 (for formal communications intended for entry);

or faxed to:

(703) 746-7290 (for informal or draft communications with notation of "Proposed" or "Draft" for the desk of the Examiner).

Hand-delivered responses should be brought to:

Receptionist, Crystal Park II
2121 Crystal Drive,
Arlington, Virginia.

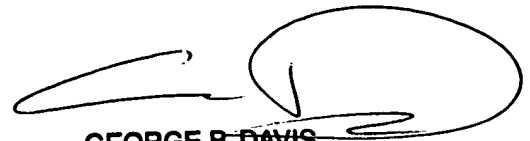
Joseph P. Hirl

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GEORGE B. DAVIS
PRIMARY EXAMINER